

No. 2918.

United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT.

Union Tool Company,	} <i>Appellant,</i>
<i>vs.</i>	
Elihu C. Wilson,	} <i>Appellee.</i>

Appellant's Answer to Appellee's Answer to Petition for Rehearing.

WILLIAM K. WHITE,
Solicitor and Counsel for Appellant.

FREDERICK S. LYON,
Solicitor and Counsel for Appellant.

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Appellant's Answer to Appellee's Answer to Petition for Rehearing.

Preliminarily, we desire to express our regret that any errors should be found in the text of our Petition for Rehearing and to extend to this Honorable Court our profoundest apology therefor. However, we shall show herein that said errors cannot, by any possible stretch of the imagination, be tortured into having any significance so far as concerns our argument.

In fact, the most serious error (to-wit: the omission of the word "not" in the quotation on page 32 of the Petition) is absolutely destructive of the entire following argument on the question of "election." In other

words, our argument on such question is based on the contention that opposing counsel did “*not*” attempt to dodge such election and that he never did dodge such election, and that, therefore, the lower court was not justified in ignoring his said “election,” from which opposing counsel never sought to be relieved.

The criticisms of opposing counsel will be discussed under the following heads, to-wit:

1. The cut of the Double improved underreamer body on the insert opposite page 13 of the Petition is a correct and accurate illustration of the Double underreamer body in evidence and such cut is a reproduction of the cut appearing on page 18 of the same catalogue from which opposing counsel secured the cut appearing opposite page 8 of his answer to the Petition. Said catalogue will be filed herewith.

2. The photograph appearing opposite page 7 of opposing counsel’s answer to the Petition is a photograph of an underreamer body so worn or deliberately broken as to give it the appearance of having a forked body, and this use of such photograph is an attempt to deceive this Honorable Court.

3. The errors in the text of the Petition are of no significance, but due to inadvertence and oversight.

Furthermore, Judge Cushman’s opinion, as set forth in the record, has now been found to differ from that appearing in the Federal Reporter, in regard to punctuation, paragraphing and spelling.

I.

The argument, in the Petition, on the question of infringement is based upon the following premises:

a. The patentee Wilson originally attempted to secure a claim covering broadly the combination of any type of underreamer *body* + lugs.

b. The patent office refused to grant Wilson any such broad claim and compelled him to limit his claim to a *forked or pronged body* + lugs.

c. That each of the types, "Double Improved," "D" and "E," has a body substantially identical with the prior patented Double body and *not* the Wilson *forked or pronged body*.

d. That each of said types, "Double Improved," "D" and "E," embodies lugs, and no attempt was made by us to point out any differences in regard to the lugs respectively embodied in the types, "Double Improved," "D," "E," the Wilson underreamer and the prior O'Donnell and Willard underreamer.

Our argument assumed all said lugs to be identical in every respect.

The point of our argument was that the respective *bodies* of the "Double Improved," "D" and "E" were *not forked or pronged bodies*.

The cuts, appearing on the insert opposite page 13 of the Petition, were selected and used *for the sole purpose* of demonstrating the *absence*, in each of said types, "Double Improved," "D" and "E," of such a *forked body*.

The cut of the "Double Improved" body, appearing on said insert, is a reproduction of the cut appearing

on page 18 of one of appellant's 1911 catalogues. Said cut is an exact representation of one of the exhibits in evidence, as this Honorable Court can ascertain by examining the exhibit.

On the opposite page is an actual photograph of said exhibit and the same was taken on last Saturday, April 27, 1918. In said photograph only the lower end of the underreamer is shown, as the upper end or "sub" has no bearing on this controversy.

Opposite page 8 of opposing counsel's answer appears a reproduction of cuts appearing on page 19 of the catalogue, which will be filed herewith. Opposing counsel, in regards to such reproduction, says:

"Why wasn't appellant honest enough to place before Your Honors this true picture of the "Double Improved" reamer, which it had on hand in its own catalogue, instead of producing a deceptive picture?"

A mere glance at said cuts shows why they were not used. *They do not plainly show that the body of the underreamer is not a forked body*, and, therefore, do not disclose the premise of our entire argument. Why should we select a cut for the purpose of emphasizing the details of construction of the lug formation when no point is made in the argument regarding any difference between any lugs? *The argument is based on an assumed identity of such lugs.*

At this point we call attention to the fact that on page 18 of this same catalogue, *and opposite page 19 thereof*, there is the same cut which was reproduced in the Petition. Notwithstanding such fact, and notwithstanding opposing counsel's necessary knowledge



of such fact, *by reason of having made use of said page 19*, he asks:

“Why wasn’t appellant honest enough to place before Your Honors this true picture of the “Double Improved” reamer, which it had on hand in its own catalogue, instead of producing a deceptive picture?”

At the very moment when he was asking such question he necessarily knew that said cut used by us was not “*a deceptive picture.*” but a reproduction of the cut appearing on the page opposite page 19 of appellant’s said catalogue, and a portion of which page 19 he reproduces opposite page 8 of his answer. On page 11 of his said answer he refers to this cut as “*especially constructed,*” notwithstanding he necessarily knew it was taken from page 18 of this catalogue.

On the day the Petition was filed the writer exhibited to opposing counsel the Petition and directed his attention to the cuts therein for the purpose of ascertaining if he had any criticism thereof to offer, because all of said cuts were not exhibits in the case.

Opposing counsel said the lugs in the cut of “Double Improved” were not sufficiently emphasized. The writer, therefore, immediately asked opposing counsel to go with him to Judge Hunt’s chambers, so the matter could be adjusted to the entire satisfaction of opposing counsel. Such a visit was immediately made, as referred to by opposing counsel on page 6 of his answer. During such conference *the writer* suggested the writing of the word “lug” on the cut and drawing a line therefrom to the lug element so as to even more plainly indicate what was already perfectly apparent.

This suggestion met with opposing counsel's approval and he acquiesced in the sufficiency of such notation to meet his criticism. The writer obtained Judge Hunt's permission to make such notation and immediately thereafter did so in ~~all~~ ^{use of the judges} copies of the Petition on file ^{for}.

Having so complied with opposing counsel's wishes in the matter the writer considered the incident closed. Notwithstanding the foregoing, opposing counsel has the audacity, on page 6 of his answer, to state Judge Hunt gave *instructions* to the writer to correct the drawing and "*This has not been done.*"

Evidently opposing counsel found it impossible to answer the argument in the Petition and, therefore, has resorted to a tirade of vituperation and abuse to divert the court's attention from the merits of such argument. Furthermore, in order to destroy the major premise of the argument, opposing counsel has resorted to a faked photograph, which might easily be interpreted as showing an underreamer having a *forked body*.

II.

This photograph appears opposite page 7 of opposing counsel's answer. An inspection of this photograph shows that the lug face, in line with the slot in the web, has been either worn or *deliberately broken*, so that the slot extends to the very end of the underreamer, thus completely dividing the web into two prongs or forks. We incline to the theory that this device was deliberately broken before being photographed, because we have asked opposing counsel an opportunity to inspect the same and he has refused to

permit such an inspection. His refusal is evidently based upon a desire to conceal something from us, and so conceal it from the court.

On page 7 of his answer opposing counsel discloses his guilty conscience in regard to such *misleading* photograph, by saying the device shown therein was “*selected at random.*” Why did he take the initiative in stating this particular device was “*selected at random*” and not selected for a particular purpose? Of what importance was it whether the device was selected “*at random*” or not, provided it truthfully and correctly represented a “Double Improved” underreamer as made and sold? By the use of such expression, “*at random,*” is it not apparent opposing counsel is laying a foundation for the defense that it was not deliberately selected for the purpose of deceiving this Honorable Court into a belief that the “Double Improved” embraces a *forked body*, thus destroying the premise of our whole argument on non-infringement?

To use counsel’s own expression, why wasn’t he honest enough to draw the court’s attention to the fact that said photograph discloses an underreamer *so mutilated* and, therefore, was not a correct photograph of any underreamer as made and sold by appellant?

The reason is plain. Counsel cannot answer our argument in any way other than by diverting the court’s attention away from the merits thereof and by deceiving the court with such a misleading photograph.

If appellee’s counsel honestly believed that appellant’s cut was not a true representation, and wished Your

Honors to have before you a true representation of the Double Improved Reamer body, why did he not, while in San Francisco, photograph the exhibit and produce such photo? Why resort to a worn out broken body?

III.

On page 32 of the Petition the word “*not*” is left out of the quoted sentence: “We have *not* attempted to dodge the election made in this case, * * *.” The omission of such word was obviously not intentional, because the whole following argument is based upon the premise that opposing counsel, *in fact*, did *not* attempt to dodge the election. As the sentence reads, with the word “*not*” omitted, it is destructive of the whole of said argument.

The other errors in the Petition are of a trivial nature and of no possible significance. Nevertheless, we deeply regret their occurrence and the same will be corrected. It is to be noted Judge Cushman’s opinion, as set forth in the record, and as reported in the Federal Reporter, differs in respect to spelling, punctuation and paragraphing. Furthermore, it contains an erroneous quotation from the record.

The affidavit of Frederick S. Lyon, with accompanying exhibits, is filed herewith.

Very respectfully submitted,

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Solicitor and Counsel for Appellant.

FREDERICK S. LYON,

Solicitor and Counsel for Appellant. B. O. .
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